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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,197	08/21/2001	Daisuke Ito	0879-0346P	6456

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EXAMINER

JONES, HEATHER RAE

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/933,197	Applicant(s) ITO ET AL.	
	Examiner Heather R. Jones	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed August 8, 2006 have been fully considered but they are not persuasive.

The Applicant argues on page 12, lines 1-5 that by modifying the devices disclosed in Watanabe et al. to permit wireless communication between the camera-integrated type VTR and the stationary VTR would increase the cost. The Examiner respectfully disagrees. The Applicant provides no basis for the assertion that including a modem in Watanabe would prevent Watanabe from achieving a "low cost" device. Furthermore, regarding the low cost argument, the fact that a combination would not be made by businessmen for economic reasons does not mean that person of ordinary skill in the art would not make the combination because of some technological incompatibility (MPEP 2145 VII). See *In re Farrenkopf*, 713 F.2d 714, 219 USPQ 1 (Fed. Cir. 1983). The benefits of wireless communication are well known and have been set forth in the rejection.

The Applicant argues on page 12, lines 14-16 and page 12, line 28 – page 13, line 4 that it is well established that the teaching or suggestion to make the asserted combination or modification of the primary reference must be found in the prior art and cannot be gleaned from Applicants' disclosure and that the Examiner's reliance on the same motivation from Freeman to modify Watanabe et al. has already been previously decided by the Board of Appeals, and, as

such, is prohibited by *res judicata* and collateral estoppel. In the Decision by the Board of Appeals mailed December 28, 2005, the Board decided that there was no motivation to modify Watanabe et al. to permit transmission of image data wirelessly (See pages 6 and 8 of Decision). As the Board of Appeals has already decided this issue, Applicants respectfully submits that the reassertion of this statement of motivation in support of the modification of Watanabe et al. is wholly improper. The Examiner respectfully disagrees. The MPEP states to that the motivation or suggestion to modify a reference or to combine reference teachings must either be in the reference themselves or in the knowledge generally available to one of ordinary skill in the art (MPEP 706.02(j) and 2144). The motivation to use a wireless connection so communication would be made easier by being accessible in areas where standard lines are inaccessible is knowledge generally available to one of ordinary skill in the art and just happens to be in the Freeman reference that is no longer being used. Regarding the fact that the Board decided that there was no motivation to modify Watanabe et al. to permit transmission of image data wirelessly (See pages 6 and 8 of Decision). The board decided there was no motivation to modify Watanabe with the teachings from the Freeman reference and not the Steinberg et al. reference. Therefore, the motivation can still be used to combine Watanabe reference with the Steinberg et al. reference.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 5, 10, 12, 14, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (U.S. Patent 5,953,481) in view of Steinberg et al. (U.S. Patent 5,862,217).

Regarding claims 1 and 12, Watanabe et al. discloses a reproducing apparatus having an editing function, which includes a camera-integrated type VTR that comprises a body (10), a control part provided to the body (2), the control part (2) being operated by a user (the control part (2) is operated by the user through the input key group (5)); a communication device which transmits image data (col. 10, lines 16-20); and a wireless communication device (3) that transmits operation information corresponding with operation of the control part (2) to an external apparatus (11) to remotely control the external apparatus (11) (col. 9, lines 61-67; col. 10, lines 1-38) when within a predetermined distance therefrom. Watanabe et al. does not specifically disclose that the wireless communication device transmits image data.

Referring to the Steinberg et al. reference, Steinberg et al. discloses a remote video transmission system wherein image data is transmitted wirelessly from a camera-integrated device (10) to an external apparatus (12) (Fig. 1; col. 2, lines 49-64; col. 3, lines 31-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the image data transmitted by Watanabe et al. would be transmitted wirelessly, in the manner taught by Steinberg et al., so communication would be made easier by being accessible in areas where standard lines are inaccessible.

Regarding claims 5 and 17, Watanabe et al. discloses a reproducing apparatus having an editing function, which includes a camera-integrated type VTR that comprises a body (10), a control part provided to the body (2), the control part (2) being operated by a user (the control part (2) is operated by the user through the input key group (5)); a communication device which transmits image data (col. 10, lines 16-20); and a wireless communication device (3) that transmits operation information corresponding with operation of the control part (2) to an external apparatus (11) to remotely control the external apparatus (11) (col. 9, lines 61-67; col. 10, lines 1-38) when within a predetermined distance therefrom. Watanabe et al. does not specifically disclose a taking lens; an imaging device which converts a light which has entered the electronic camera through the taking lens into electrical signals; a recording device which records an image captured by the imaging device in a storage medium; or that the wireless communication device transmits image data.

Referring to the Steinberg et al. reference, Steinberg et al. discloses an electronic camera comprising a taking lens; an imaging device which converts a light which has entered the electronic camera through the taking lens into

electrical signals; and a recording device which records an image captured by the imaging device in a storage medium (Figs. 1 and 2; col. 3, lines 40-55). Furthermore, Steinberg et al. discloses a remote video transmission system wherein image data is transmitted wirelessly from a camera-integrated device (10) to an external apparatus (12) (Fig. 1; col. 2, lines 49-64; col. 3, lines 31-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the image data transmitted by Watanabe et al. would be transmitted wirelessly, in the manner taught by Steinberg et al., so communication would be made easier by being accessible in areas where standard lines are inaccessible.

Regarding claim **10**, Watanabe et al. in view of Steinberg et al. discloses all the limitations previously discussed with respect to claim 1 as well as Watanabe et al. further disclosing that the control part (2) comprises an operation key (input key group (5)).

Regarding claim **14**, Watanabe et al. in view of Steinberg et al. discloses all the limitations previously discussed with respect to claims 1 and 10 as well as disclosing transmission of image data occurs when the camera is within a predetermined distance of the external apparatus (the camera and external apparatus would have to be within a predetermined distance from each other to allow the transmission of image data and information relating to the image data for storage on the external apparatus to occur without encountering the specified difficulties).

Regarding claim **25**, Watanabe et al. in view of Steinberg et al. discloses all the limitations previously discussed with respect to claim 1 as well as further comprising a storing device that stores identification information for specifying the external apparatus (col. 8, lines 8-12); a specifying device that specifies the external apparatus from the identification information stored in the storing device (col. 9, lines 50-55); and enciphering device that enciphers, according to the identification information, at least one of the image data and the operation information (col. 8, lines 8-12 – the remote-control signals which are respectively associated for use with the VTRs as registered).

4. Claims 2, 9, 11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. in view of Steinberg et al. as applied to claim 1 above, and further in view of Matsumoto et al. (U.S. Patent 5,796,428).

Regarding claim **2**, Watanabe et al. in view of Steinberg et al. discloses all the limitations as previously discussed with respect to claim 1 as well as Watanabe et al. further disclosing that the external apparatus (11) comprises a wireless communication device (12) that communicates with the camera (10) to receive accessory information. However, Watanabe et al. in view of Steinberg et al. fail to disclose a processor configured to classify images received from the camera into image groups according to the accessory information and create virtual folders, each of the virtual folders comprising each of the image groups, and a displaying device which displays the virtual folders.

Referring to the Matsumoto et al. reference, Matsumoto et al. discloses an electronic photography system. Image data is captured by image capturing unit (101) and stored along with attribute data of the picture image data (col. 7, lines 53-56). The storage/display unit accepts the attribute and image data from the image-capturing unit, display controller (112) creates album data based on the image and attribute data (col. 7, lines 57-61; col. 8, lines 18-19), and displays data on the display (113). Display controller (112) classifies images received from image capturing unit (101) into groups according to attribute information and creates albums (virtual folders) that contain the image groups (col. 9, lines 53-56; see Figs. 5, 7, 8), and display device (113) displays the albums (virtual folders).

It would have been obvious to one of ordinary skill in the art at the time the invention was made that auxiliary data could be used to group images taken by the apparatus disclosed by Watanabe et al. in view of Steinberg et al. into "albums" based on the attribute data, in the manner taught by Matsumoto et al., to designate which folder to put images in, to keep related pictures together in a place where they are easily accessible, and to minimize rearrangement and loss of pictures.

Regarding claims **9**, **11**, and **15**, Watanabe et al. in view of Steinberg et al. discloses all the limitations as previously discussed with respect to claims 1 and 5. Furthermore, Watanabe et al. in view of Steinberg et al. in view of Matsumoto et al. discloses a processor configured to classify images as discussed above with reference to the rejection of Claim 2. Furthermore, Matsumoto et al. further

discloses the external apparatus comprises a storage/display controller (111) that comprises an inherent memory for storing program instructions, and a display controller (112) responds to these instructions to classify received images.

5. Claims 3, 4, 6, 7, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. in view of Steinberg et al. as applied to claims 1 and 10 or 5 above, and further in view of Freeman et al. (U.S. Patent 5,579,239).

Regarding claims 3, 4, and 13, Watanabe et al. in view of Steinberg et al. discloses all the limitations as previously discussed with respect to claim 1 as well as Watanabe et al. further disclosing a storing device (4) that stores identification information for specifying the external apparatus (11) (col. 8, lines 8-12) and a specifying device (5) that specifies the external apparatus from the identification information stored in the storing device (11) (col. 9, lines 50-55). However, Watanabe et al. in view of Steinberg et al. fail to disclose an encoding device that encodes the image data and the operation information according to the identification information or a decoding device in the external apparatus that decodes, according to the identification information, the encoded data received from the electronic camera.

Referring to the Freeman et al. reference, Freeman et al. discloses a video transmission system comprising an encoding device that encodes, according to the identification information, image data and the operation information and a decoding device that decodes, according to the identification

information, the encoded data received from the electronic camera (col. 5, lines 4-7; col. 6, lines 44-49; col. 7, lines 21-33; Abstract, lines 1-6).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to compress and decompress the image data transmitted by Watanabe et al. in view of Steinberg et al., in the manner taught by Freeman et al., to be able to use low bandwidth lines and reduce time needed to transmit data across the lines. It would have been further obvious to encode one of the image data and operation information, and decode the encoded data, in the manner taught by Freeman et al., to ensure accurate data is sent to the appropriate external device.

Regarding claim 6, Watanabe et al. in view of Steinberg et al. in view of Freeman et al. discloses all the limitations previously discussed with respect to claim 4 as well as Steinberg et al. further disclosing that the external unit (12) has a displaying device which displays the image (Fig. 1; col. 3, lines 31-35). Freeman et al. also discloses that the external unit has a displaying device that displays the image (col. 4, lines 28-31; col. 5, lines 2-3).

Regarding claim 7, grounds for rejecting claim 3 apply for claim 7 in its entirety.

Regarding claim 16, Watanabe et al. in view of Steinberg et al. in view of Freeman et al. discloses all the limitations previously discussed with respect to claims 1, 10, and 13 as well as disclosing transmission of image data occurs when the camera is within a predetermined distance of the external apparatus

(the camera and external apparatus would have to be within a predetermined distance from each other to allow the transmission of image data and information relating to the image data for storage on the external apparatus to occur without encountering the specified difficulties).

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. in view of Steinberg et al. in view of Matsumoto et al. as applied to claim 15 above, and further in view of Freeman et al. (U.S. Patent 5,579,239).

Regarding claim **18**, grounds for rejecting claim 3 apply for claim 18 in its entirety.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. in view of Steinberg et al. and Matsumoto et al. (U.S. Patent 5,796,428).

Regarding claim **19**, see rejection of Claims 14 and 16 above.

8. Claims 20/1, 20/5, 20/12 and 20/17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. in view of Steinberg et al. as applied to claims 1 and 12 above, and further in view of Peters (U.S. Patent 6,601,093).

Regarding claims **20/1, 20/5, 20/12, and 20/17**, Watanabe et al. in view of Steinberg et al. discloses all the limitations as previously discussed with respect to claims 1 and 12, but does not specifically disclose the wireless communication device automatically initiates communication with the external device without any action by the user when the camera is within a predetermined distance of the external apparatus.

Referring to the Peters reference, Peters discloses a networking environment that utilizes the Bluetooth™ technique, which is a technique that enables devices containing radio modems to be automatically detected upon coming into radio proximity with one or more other similarly-equipped devices (col. 6, lines 44-49). Peters gives the example of this technique being utilized between a wireless computer and server, wherein the wireless computer establishes communication with the server upon coming into proximity of the signal field of the server (col. 4, lines 41-50). Peters further states that the low-powered radio module defined by Bluetooth standard is intended to be built into various devices, including digital cameras (col. 6, lines 59-64), and that the advantages of using this technology include offering a great convenience to users in that devices can easily be added or moved without the inconvenience and expense of cables or in-premises wiring (col. 5, lines 1-19).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the Bluetooth technique disclosed by Peters into the electronic camera of Watanabe et al. in view of Steinberg et al., making the camera a Bluetooth-enabled device, to offer a great convenience to users in that the camera can easily be moved without the inconvenience and expense of cables or in-premises wiring when connected to the external device, and also to reduce power consumption which would occur if the external device was left on when not in use, but rather would turn the external device on when the camera is within a predetermined distance.

9. Claims 20/2, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. in view of Steinberg et al. in view of Matsumoto et al. as applied to claim 2 above, and further in view of Peters (U.S. Patent 6,601,093).

Regarding claim **20/2**, see the previous rejection of claim 20/1 above.

Regarding claims **21** and **22**, grounds for rejecting claim 20/2 applies for claims 21 and 22 in their entirety.

10. Claim 20/4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. in view of Steinberg et al. in view of Freeman et al. as applied to claims 4, 9, 11, or 15 above, and further in view of Peters (U.S. Patent 6,601,093).

Regarding claim **20/4**, see the previous rejection of claim 20/1 above.

11. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. in view of Steinberg et al. and in view of Peters (U.S. Patent 6,601,093).

Regarding claim **23**, see the rejection of claims 1 and 20 above.

Regarding claim **24**, see the rejection of claims 5 and 20 above.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather R. Jones whose telephone number is 571-272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

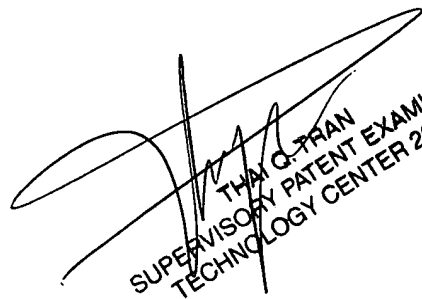
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

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Heather R Jones
Examiner
Art Unit 2621

HRJ
October 27, 2006



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